07-22-04

1652

St. Jude Children's Research Hospital
ALSAC · Danny Thomas, Founder

Office of Technology Licensing
t 901.495.2342 f 901.495.3148

"Express Mail" Mailing label number: EL 402017512 US
Date of Deposit: July 21, 2004

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Regina D. McKinney

July 21, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Mail Stop Amendments

Re: Appl. No.10/078,927; Filed: February 19, 2002
For: Cyclin Dependent Kinase 5 Phosphorylation of Disabled 1 Protein
Inventors: Thomas Curran, *et al*
Our Ref: SJ-01-0032

Sir:

The following documents are forwarded herewith for appropriate action by the U.S. Patent and Trademark Office:

1. Response to Restriction Requirement (3 pages)

2. A self-addressed and stamped return postcard

Regards,

Shawn A. Hawkins

Shawn A. Hawkins
Agent for Applicant
Registration No. 50,318
Associate Director, Office of Technology Licensing

Enclosures

"Express Mail" Mailing label number: EL 402017512 US
Date of Deposit July 21, 2004

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Regina D. McKinney

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:	
Curran *et al.*	:	Art Unit: 1652
Serial No. 10/078,927	:	Examiner: David J. Steadman
Filed: February 19, 2002	:	Atty Docket: SJ-01-0032
For: Cyclin Dependent Kinase 5 Phosphorylation of Disabled 1 Protein	:	

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement mailed on June 30, 2004, and in accordance with Rules 142 and 143 of the Rules of Practice, please consider the following election and remarks.

In the Office Action, the Examiner required restriction to one of the following Groups of claims under 35 U.S.C. § 121:

Group I: Claims 1-15, 23, 25, and 31, drawn to a method for detecting cyclin dependent kinase (Cdk5) activity, a method for detecting neurological disorders by assaying for a decrease in Cdk5 activity, and a method for quantitating the level of Cdk5 activity in a biological sample, class 435, subclass 15.

Group II: Claims 1-15, 22, 24, and 31, drawn to a method for detecting Cdk5 activity, a method for detecting neurological disorders by assaying for an increase in Cdk5 activity, and a method for quantitating the level of Cdk5 activity in a biological sample, classified in class 435, subclass 15.

Group III: Claims 16-17, drawn to a method for identifying a compound that inhibits or decreases Cdk5 activity, classified in class 435, subclass 15.

Group IV: Claims 18-19, drawn to a method for identifying a compound that increases Cdk5 activity, classified in class 435, subclass 15.

Group V: Claim 20, drawn to a method for treating Alzheimer's disease and ALS by administering a Cdk5 inhibitor, classified in class 514, subclass 789.

Group VI: Claim 21, drawn to a method for treating epilepsy and lissencephaly by administering a Cdk5 activator, classified in class 514, subclass 789.

Group VII: Claims 26-30, drawn to an antibody, and a screening kit comprising said antibody, classified in class 530, subclass 387.9.

The Examiner contents that the inventions are distinct because allegedly (i) the methods of Groups I - VI comprise different steps, utilize different products and/or yield different results, (ii) the process for using the product of Group VII can be practiced with another materially different product or the product of Group VII can be used in a materially different process, such as an affinity reagent for the purification of a phosphopeptide, and (iii) the product of Group VII is unrelated to the methods of Groups V and VI. The Examiner asserts that the inventions of Groups I – VII are independent or distinct and co-examination of the inventions of Groups I – VII would place a serious burden on the Examiner.

In order to be fully responsive to the Requirement for Restriction, applicants hereby elect, with traverse, to prosecute the claims of Group I (claims 1-15, 23, 25 and 31) directed to a method for detecting Cdk5 activity, a method for detecting neurological disorders by assaying for a decrease in Cdk5 activity, and a method for quantitating the level of Cdk5 activity in a biological sample.

Although applicants are making the above election to be fully responsive to the Requirement for Restriction, applicants respectfully traverse the Requirement. In particular, applicants respectfully request reconsideration of the Restriction Requirement to allow prosecution of all pending claims in the same application, or, in the alternative,

modification of the Requirement to allow prosecution of more than one of the above groups, for the reasons provided as follows.

Applicants respectfully submit that Groups I and II fail to define methods that warrant separate examination and search. The methods in both Groups depend ultimately from Claim 1 and utilize the same steps and products. Furthermore, the Claims of both Groups are classified in the same search class (435) and the same subclass (15). Furthermore, Groups I – IV fail to define inventions that warrant separate examination and search. Claims of Groups I – IV are fundamentally related and are classified in the same search class (435) and the same subclass (15). Accordingly, searches of claims within these four groups will be coextensive.

Likewise, the methods of Groups I through VI are all based on methods for detecting Cdk5 activity. Furthermore, the antibody of Group VII can be used as a product for detecting Cdk5 activity in accordance with the methods of Groups I – VI and as a product in the methods for identifying the Cdk5 inhibitor or activator of Groups V and VI.

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions (MPEP § 803). Hence, it is believed that a single search of the features of the methods in the elected Group I would necessarily and unescapably require a search of the subject matter of the claims of Groups II – IV and will overlap with the search of the subject matter of Groups V - VII.

In accordance with the remarks above, applicants respectfully submit that conjoint examination and inclusion of all the Claims of the present application would not present an undue burden on the Examiner and request that the Restriction Requirement be reconsidered and withdrawn, or at least modified to include Claims drawn to Groups I – IV, for the reasons set forth herein.

In the event that this Restriction Requirement is maintained, Applicants reserve the right to petition under 37 C.F.R. § 1.144 to obtain further review of this Requirement.

No fee is believed to be required for consideration of this submission. If applicants are incorrect and a fee is required, the Commissioner is hereby authorized to charge such fee to Deposit Account No. 501968.

Respectfully submitted,

Shawn A. Hawkins

Shawn A. Hawkins
Agent for Applicant
Registration No. 50,318